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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/213,656 12/17/98 MORGAN

S AT9-98-343

EXAMINER

WM01/0322

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| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2641

DATE MAILED:

03/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|---------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/213,856 | MORGAN ET AL. |
| | Examiner Angela A. Armstrong | Art Unit 2641 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 January 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

18) Interview Summary (PTO-413) Paper No(s) _____.

19) Notice of Informal Patent Application (PTO-152)

20) Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/213,858. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims includes the limitations of predetermining a plurality of speech commands associated with a corresponding plurality of system actions, detecting speech commands and words associated with speech commands, displaying speech commands, performing the corresponding system action if a particular command is selected. Application No. 09/213,858 does not teach determining relevant commands or displaying relevant commands. Refer to White (US Patent No. 5,836,494) who teach a computer system having speech recognition functionality which upon recognizing a command can display a list of alternative commands or paraphrases or synonyms associated with

a command, for the purpose of allowing the user to correct an erroneous interpretation (col. 3, lines 32-34).

3. Therefore, it would have been obvious to one of ordinary skill at the time of invention to modify the speech recognition system of Application No. 09/213,858 to display relevant commands for the purpose of allowing the user to correct an erroneous interpretation, as taught by White.

4. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (US Patent No. 5,386,494).

7. Regarding claims 1, 6, and 11

Predetermining a plurality of speech commands for respectively initiating each of a corresponding plurality of system actions is taught by White at Figures 5A-5C; Col. 7, lines 16-23;

Providing for each of said plurality of commands, an associated set of speech terms is taught by White at col. 8, lines 43-54;

Detecting speech commands and speech terms is taught by White at col. 4, lines 51-52;

Displaying said command is taught by White at Figures 5A-5C; col. 7, lines 45-48;

Displaying the relevant command is taught by White at Figures 5A-5C; col. 8, lines 25-42;

8. Regarding claims 2, 7, and 12

Selecting a displayed command to thereby initiate a system action is taught by White at Figure 5A; col. 7, lines 45-68; col. 8, lines 1-7;

9. Regarding claims 3, 8, and 13

Selecting displayed command include speech command input means is taught by White et al. at col. 9, lines 53-57;

10. Regarding claims 4, 9, and 14

Speech commands and relevant commands are displayed simultaneously is taught by White at Figures 5A and 5C;

11. Regarding claims 5, 10, and 15

Relevance table of speech input commands... is taught by White at Figure 5C; col. 7, lines 45-59; col. 8, lines 43-54;

Relating interactive terms with terms in the relevance table is taught by White at Figures 5C; col. 7, lines 45-59; col. 8, lines 43-68; col. 9, lines 1-10;

Response to Arguments

12. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela A. Armstrong whose telephone number is 703-308-6258. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on 703-305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6306 for regular communications and 703-308-6296 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

AAA
March 15, 2001

William Korzuch
WILLIAM KORZUCH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600